

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing and that a clear issue between applicant and examiner should be developed, if possible, before appeal. ...

[The grounds of rejection] must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Considering now the claim rejections, the Office Action rejected claims 87, 88, 118, and 119 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action asserted that the phrase "an information element purported to match ..." is unclear as to its meaning and renders the claims indefinite. Since those claims had not been amended, this rejection was based on a new ground that was not necessitated by applicants' amendments in response to the previous Office Action. For this reason, applicants respectfully submit that it was improper to make the Office Action final.

Also, applicants believe that the grounds of rejection under Section 112 were not fully developed, since the Office Action did not indicate why the phrase was considered unclear. As a result, it is difficult for applicants to try to reword this phrase to remove the alleged indefiniteness. In this regard, applicants submit that the meaning of the phrase "an information element purported to match ..." is clear and definite. This phrase finds support at various places in the specification of the application, including for instance the following:

In accordance with an embodiment of the present invention, the authenticator further comprises a verification mechanism for verifying the authenticity of a set of information elements purported to be identical to the original set of information elements.

Page 26, lines 30-34.

The Comparator 124 also has input means for inputting the corresponding information elements purported to be identical to the stored elements. The comparator 124 then compares the corresponding information elements to determine if they are the same, and the comparison result can be output for example to a display or printing unit.

Page 28, lines 2-4.

The phrase at issue as used in these quoted portions has a clear and ordinary meaning that is not ambiguous or indefinite. According, it is respectfully submitted that the Section 112 rejection should be withdrawn.

Turning to the rejections based on prior art, claims 64-66, 69, 71-79, 92-96, 98, 100, 101, 103-111, 123-127, 131, 132, 134, 137-140, 144, 145, 149-151, 153, 154, and 160 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouricius et al. (U.S. Patent 4,326,098) and an Official Notice that will be discussed in detail below. Claims 68, 80, 97, 111, 133, 147, 155, 158 and 161 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bouricius et al. reference and various Official Notices. Claim 159 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneier in view of further Official Notices.

It is applicants' position that the Office Action was prematurely made final with respect to these claims. To put the discussion in perspective, a brief recount of the application prosecution to date is believed to be useful. In the first Office Action, the previous Examiner (Examiner Trevor Coddington) rejected independent claims 64, 94, 125, 137, 149, and 160 as well as selected dependent claims under 102(b,e) as being anticipated by Bouricius et al. Claim 159 was rejected under 35 U.S.C. § 102(b) as being anticipated by Schneier. Independent claims 158 and selected dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouricius et al. in combination with Official Notices. With respect to claim 137 that was directed to an "authenticator", the first Office Action rejected the claim by asserting: "The applicants' claimed authenticator performs the Applicant's claimed method for authenticating." In the responsive Amendment, claim amendments were made such that all the independent claims require an authenticator that functions as a non-interested third party with respect to the sender and the recipient and generates and stores the dispatch authentication information. The second Office Action to which this Request is responsive repeated the same grounds of rejection given in the first Office Action, but added an Official Notice regarding the authenticator, and converted the original Section 102 rejections into Section 103 rejections. The Office Action was made final.

Applicants respectfully submit that the finality of the Office Action is not proper because applicants' amendments did not necessitate new grounds of rejection. As discussed above, the only new ground of rejection in the Office Action involves an Official Notice concerning the authenticator. Claim 137 as originally filed, however, explicitly claimed such an authenticator. Also, claim 149 as originally filed recited an information dispatch system that has an authenticator. The non-interested third-party nature of the authenticator was clear from the language of original claims 137 and 149. Since the "authenticator" limitation was already in some of the original claims (although not adequately addressed in the first Office Action), the amendments adding this limitation to the other claims did not necessitate new grounds of rejection. Accordingly, it is believed that the finality of the second Office Action was improper.

Applicants also submit that the finality of the second Office Action was improper for the reason that the Action did not fully develop the grounds of the rejections. As described above, the first Office Action did not give due weight to the "authenticator," and applicants responded by adding this limitation to each of the independent claims to emphasize its importance. The second Office Action, however, relied on an Official Notice to find the authenticator. Specifically, the Office Action asserted:

Although Bouricius does not specifically teach an authenticator functioning as a non-interested third party with respect to the sender and the recipient, such an authenticator acting in such a manner is a feature that is old and well known in the art. Therefore it would have been obvious to one of ordinary in the art at the time the invention was made to have incorporated this feature into the method of Bouricius et al.

Applicants feel that the use of an Official Notice to find a critical claim limitation did not quite provide applicants with an adequate perspective of what is in the prior art for developing the issue of patentability of the claimed invention. Accordingly, applicants respectfully request that the finality of the Office Action be withdrawn to avoid prematurely cutting off the prosecution of the application.

Finally, it is applicants' position that it would not have been obvious to combine any "such an authenticator" with the system of Bouricius et al. to reach the claimed invention. First of all, applicants respectfully traverse the assertion in the Office Action that "such an authenticator acting in such a manner is a feature that is old and well known in the art." Second, applicants submit that it would not have been obvious to combine "such an authenticator" with the system of Bouricius et al. to somehow reach the claimed invention. This is because the system of Bouricius et al. and the present invention are based on two entirely different conceptual models. As discussed in great detail in the previous Amendment, the system of Bouricius et al. is based on a model in which the sender and recipient of a dispatched document exchange signed copies of the document as proof of the dispatch. Thus, both the sender and recipient in the system of Bouricius et al. are responsible for generating, exchanging, and storing the proof of a dispatched document. The system of Bouricius et al. has a vault for assisting the sender and recipient of the dispatch to accomplish authenticated correspondence with each other. Although the vault is a non-interested third party in that process, it does not generate or store any dispatch evidence. Rather, it serves merely as a secure and reliable communication channel between the correspondents. In this regard, by relying on the Official Notice regarding the "authenticator" limitations, the Office Action clearly recognized that the vault of Bouricius et al. is not the authenticator of the claimed invention. The Bouricius et al. system has been discussed in great detail in the previous Amendment. To avoid repeating the same discussion, the discussion in the previous Amendment regarding the Bouricius et al. system, including the comparison of that system with the claimed invention, is hereby incorporated by reference.

In sharp contrast to the Bouricius et al. approach, in the claimed invention, neither the sender nor the recipient is concerned with generating or storing authentication information for the dispatch. Rather, it is the authenticator operating as a non-interested third party that generates the authentication information and secures it from tampering by the sender and/or the recipient. It is critical to note that since the sender and recipient in the system of

Bouricius et al. are themselves responsible for generating and storing the proof of dispatch, that system does not have any need or any room for an authenticator of the claimed invention. This is because the signing of the dispatched document by the sender and recipient and exchanging the signed document is already sufficient for certifying the contents and dispatch of the document. Thus, it would not have been obvious to try to combine such an authenticator with the system of Bouricius et al. to somehow reach the claimed invention.

Accordingly, independent claims 64, 94, 125, 137, 149, 158, and 160, which all include the "authenticator" limitation and were rejected based on Bouricius et al. in view of the Official Notice, should be allowable even if it is assumed that the Official Notice regarding the authenticator could be adequately supported. All the other claims except claim 159 depend from these claims respectively and should therefore also be allowable.

Independent claim 159 was rejected over Schneier in view of the Office Action about the authenticator. According to the Office Action, Schneier explains a public certificate. As discussed above, the context and manner in which the authenticator operates is important to the consideration of patentability. As discussed in great detail in the previous Amendment, the certificate issuing operation of Schneier is not related to authenticating a dispatch and its contents from a sender to a recipient, and the certificate authority of Schneider is not the authenticator of the claimed invention. Thus, it would not have been obvious to combine the system of Schneier with authenticator to reach to claimed invention, and claim 159 should be allowable.

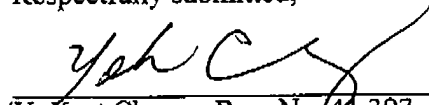
Conclusion

In view of the foregoing, applicants respectfully submit that the finality of the Office Action should be withdrawn. Moreover, applicants submit that the application is in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. In the alternative, the Examiner is respectfully requested to enter the amendments in this Response to facilitate an appeal.

In re application of Feldbau et al.
Serial No. 08/981,461

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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